

### **REMARKS/ARGUMENTS**

Claims 1, 19, 21, 24-27, 30-32, and 34-36 are pending and stand substantively rejected under 35 U.S.C. §103. In this Amendment, new claims 37-63 are added. Reconsideration is respectfully requested.

#### **Rejections**

Each of the three §103 rejections is based in part upon U.S. Patent No. 5,931,165 [“Reich”]. According to MPEP 2141.01(I), “[b]efore answering *Graham's* 'content' inquiry, it must be known whether a patent or publication is in the prior art under 35 U.S.C. §102.” Reich does not qualify as §102 prior art, and therefore must be excluded from the §103 rejections.

#### **The Instant Application**

The instant application is a continuation of USSN 09/032,370 filed February 27, 1998. At the time the presently claimed invention was made, it was owned or subject to an obligation of assignment to Fusion Medical Technologies, Inc.

#### **The Reich Patent**

Reich was filed on February 6, 1997 and published on August 3, 1999. Reich was, at the time the presently claimed invention was made, owned by or subject to an obligation of assignment to Fusion Medical Technologies, Inc.

#### **Analysis Under §102(a) and (b)**

According to MPEP 706.02(VI)(A), if an application is a continuation an earlier U.S. application, the effective filing date is the same as the earliest filing date in the line of continuation applications. Because the instant application is a continuation of an earlier application filed February 27, 1988, the effective filing date of the instant application is also February 27, 1998.

Reich was published August 3, 1999, which is after the effective filing date of February 27, 1998 for the instant application. Hence, Reich cannot qualify as a §102(a) or (b) reference.

#### **Analysis Under §102(e)**

According to MPEP 706.02(I)(1)(I), a reference cited under former 35 U.S.C. §103 via 35 U.S.C. §102(e) cannot be used as prior art against a claimed invention if that cited subject

matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person. The reference must be disqualified under the commonly assigned/owned prior art provisions of 35 U.S.C. 103(c).

Reich was filed February 6, 1997, which is before the effective filing date of February 27, 1998 for the instant application, and thus Reich can only qualify as a §102(e) reference. Reich was, at the time the presently claimed invention was made, owned by or subject to an obligation of assignment to Fusion Medical Technologies, Inc. Thus, Reich, which could only qualify under 102(e), shall not preclude patentability because of the common ownership provisions of 35 U.S.C. §103(c).

In sum, Reich cannot be included in the §103(a) rejections. Hence, the §103(a) rejections do not support a *prima facie* case of obviousness. Withdrawal of these rejections is respectfully requested.

#### **New Claims**

***Please see the CONCLUSION section below for authorization to charge additional fees as necessary for the new claims.***

New claims 37-63 are similar to claims previously pending in instant application, such as the searched and examined claims referenced in the Office Action of November 25, 2009. In contrast to the previously pending claims, new claims 37-63 involve devices consisting of a syringe and a gel.

As noted in MPEP 2111.03, the transitional phrase “consisting of” excludes any element, step, or ingredient not specified in the claim; it is a closed term, which generally closes the claim to the inclusion of materials other than those recited except for impurities ordinarily associated therewith or components unrelated to the claimed invention.

US 4,482,386 [“Wittwer”], the primary reference relied upon in the November 25, 2009 Office Action, was cited for describing various water-swallowable hydrocolloids. Wittwer’s colloids, however, are not present in a syringe or intended for delivery to a patient as recited in new claims 37-63. Instead, Wittwer’s colloids are for use in mechanical forming processes such as die molding or injection molding.

The other references of the Office Action, namely US 4,124,705 [“Rothman”], US 4,515,637 [“Cioca”], and US 6,129,761 [“Hubbell”], were cited for describing various features in addition to the hydrocolloids of Wittwer. For example, Rothman discusses a suspension of minute polysaccharide particles, Cioca discusses a collagen-thrombin hemostatic composition, and Hubbell describes certain hydrogel compositions. Yet neither Rothman, Cioca, nor Hubbell teach or suggest devices consisting of a syringe and a gel as described in new claims 37-63. Hence, these references do not remedy the deficiencies of Wittwer, and new claims 37-63 are patentable over the references of record.

### CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

Further, the Commissioner is hereby authorized to charge any additional fees or credit any overpayment in connection with this paper to Deposit Account No. 20-1430.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,

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